

R E M A R K S

Claims 1-25 were originally filed in the present application. In a Response to a *first* Restriction Requirement mailed June 9, 1999, Applicants elected to prosecute Claims 1, and 3-8 of group I, without traverse. In the present Office Action, the Examiner has both objected to the Specification for allegedly failing to comply with Sequence Rules, and has issued a *second* Restriction Requirement.

Applicants hereby cancel Claims 16-25 drawn to a nonelected invention. In addition, Applicants amend Claims 1 and 8, and introduce new Claims 26-28, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments. Applicants reserve the right to prosecute the original, similar, or broader Claims in one or more future application(s).

1. Sequence Rules

The Examiner has objected to the Specification for allegedly failing to disclose each sequence separately in both the sequence listing and in the text of the description and claims whenever described. Applicants hereby amend the legends of Figures 1 and 6, as well as a paragraph in Example 7 to *clearly* disclose each of SEQ ID NOS:1-121 in both the Sequence Listing and in the Specification. These amendments do not introduce new matter.

2. Election/Restriction

The Examiner has indicated that because the elected claims are directed toward different SEQ ID NOs: 84-103, which allegedly represent patently distinct claims, claim 1 is further restricted to an individual SEQ ID NO. In addition, the Examiner states:

"[b]ecause these inventions are distinct for the reasons given above, and the coextensiveness of the search and examination for each group would constitute an undue burden on the examiner to search and consider all the separable groups, restriction for examination purposes as indicated is proper" (Office Action, page 3).

Applicants must respectfully disagree. Applicants traverse this *second* restriction requirement as at the time this Application was submitted (*i.e.*, **October 23, 1997**), the Office was not restricting claims to a single SEQ ID NO. In addition, Applicants assert that the search and examination of the claimed inventions would not constitute an undue burden on the Examiner, as all of the claimed SEQ ID NOS are portions of a *single gene*, the human

alpha 7 neuronal nicotinic receptor. Nonetheless, Applicants have amended Claims 1 and 8, and introduced new Claims 26-28, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments and while reserving the right to prosecute the original, similar, or broader Claims in one or more future application(s).

Specifically, Applicants have amended Claim 1 to recite "a portion of the human alpha-7 neuronal nicotinic receptor, set forth as nucleotides 1-392 of SEQ ID NO:94." Support for this amendment can be found in Figure 4 of the Application as filed. Moreover, Applicants have added new Claims 26-28, which further comprise the sequences of exon 1, the intron 1 splice donor, and one or more exons of the human alpha 7 neuronal nicotinic receptor, selected from the group consisting of exon 2, exon 3, exon 4, exon 5, exon 6, exon 7, exon 8, exon 9 and exon 10, respectively. Support for the new claims can be found in the text of original Claims 3 and 4 drawn to sequences further comprising 5' and 3' flanking regions, and intervening regions, respectively. Support for new Claims 26 and 27 can also be found in Figure 4 (disclosing SEQ ID NO:94), which clearly depicts the sequence of exon 1 in upper case, while the intron 1 splice donor is shown in italicized lower case. Finally, support for new Claim 28 can be found in Figure 1 depicting the sequences of the intron/exon boundaries, in combination with Example 2 which teaches the sequence of the human alpha 7 nicotinic receptor cDNA as GenBank #U40583 (Specification, page 63, at line 13).

Similarly, Applicants have amended Claim 8 to recite a first sequence which "hybridizes under stringent conditions to a second polynucleotide sequence set forth in Claim 1, wherein said stringent conditions comprise hybridization at 40°C in 5X Denharts, and two washes at 65°C in 0.1% SDS and 0.1X SSC. Support for this amendment can be found in Example 5 which teaches the recited conditions for Southern analysis (Specification, page 71, at lines 18-21).

CONCLUSION

Applicants believe that the amendments and arguments set forth above place the instant Application in condition for *immediate* examination. However, should the Examiner believe

that a telephone interview would aid in the prosecution of this application, Applicants encourage the Examiner to call the undersigned collect.

Dated: June 11, 2003



Christine A. Lekutis
Registration No. 51,934

MEDLEN & CARROLL, LLP
101 Howard Street, Suite 350
San Francisco, California 94105
415.904.6500